

## **REMARKS**

### **I. Status of the Claims.**

Claims 1-6, 9-28, 30, 33-42, 45-50, 52-56, 59-61, 63-65, 67-69, 72-74, 76-78, 81-99, 103, 112-113, 115, 117-120 and 123 have been amended, claims 7-8, 29, 57-58, 62, 105-111, 114, and 121-122 have been canceled; new claims 124-150 have been added. Claims 1-6, 9-28, 30-56, 59-61, 63-104, 112, 113, 115-120 and 124-150 are now pending in this application.

Claims 7-8, 29, 57-58, 62, 105-111, 114, and 121-122 have been canceled solely to advance the prosecution of the present application, and without prejudice to their further prosecution in an appropriately filed continuing or divisional application.

### **II. Claim Amendments And New Claims.**

The amendments made herein have been to clarify the claims and to correct typographical errors and are not intended to limit the scope of equivalents to which any claim element may be entitled. The amendments to the claims and new claims have support throughout the specification. No new matter has been added as a result. Applicants respectfully request entry of these amendments and new claims.

#### **A. Claim Amendments**

Claims 1-6, 9-28, 30, 33-42, 45-50, 52-56, 59-61, 63-65, 67-69, 72-74, 76-78, 81-99, 103, 112-113, 115, 117-120, and 123 have been amended for clarity and consistency of claim language and/or to change the dependency, such as when the claim would otherwise be dependent on a now canceled claim.

Claim 26 has also been amended to recite "calcium sulfate," "calcium hydrogen sulfate," "calcium phosphate," "calcium hydrogen phosphate" and "calcium di-hydrogen phosphate." Support for these claimed compounds can be found in the specification, for example, on pages 12, 13 and 20, and in original claim 117.

Claims 33, 45 and 54 have also been amended to additionally recite "a metal cation hydrogen sulfate," "a metal cation sulfite," "a metal cation hydrogen sulfite," "a metal cation hydrogen phosphate" and "a metal cation di-hydrogen phosphate." Support for these claimed compounds can be found in the specification, for example, on pages 12, 13 and 20..

Claims 34 and 46 have also been amended to recite a weight percent of extenders of between about "25% to 98% of total pigment concentration." Support for this claimed range is found in the specification, for example, on page 21, par. [0067].

Claims 35, 47, 55 and 60 have also been amended to recite that at least one of the binders is an "epoxy-based resin binder." Support for this claimed binder is found, for example, in original claim 19 and in the specification, for example, on page 24, par. [0075].

Claim 39 has also been amended to additionally recite a "solid solution mixed oxide" of a rare earth containing compound. Claims 41 and 52 have also been amended to recite that the mixed oxide is a "solid solution mixed oxide." Support for these claimed compounds is found in the specification, for example, on page 22, par. [0070].

Claims 68 and 77 have also been amended to recite that the coating composition is cured naturally or with an accelerated method of curing which exposes the coating composition to "heat," "UV energy," "microwave energy," or "combinations thereof." Claims 85 and 90 have also been amended to recite that the coating composition and the one or more pretreatment coatings are each independently cured naturally or by exposure to "heat," "UV energy," "microwave energy," or "combinations thereof." Support for these claimed methods can be found in the specification, for example, on pages 6, 7 and 32.

Claims 92 and 95 have also been amended to recite the term "mill base" in place of the term "paint formulation." The recited "mill base" is described in the specification, for example, on page 27.

Claim 117 has also been amended to additionally recite "calcium hydrogen sulfate." Support for this claimed compound can be found in the specification, for example, on page 13.

#### **B. New Claims.**

##### **New Claim 124.**

Support for new Claim 124 is found in the specification, for example, on pages 18, 21, and 22, which lists the specified ranges of the claimed composition.

##### **New Claims 125-127.**

Support for new Claims 125-127 is found in the specification, for example, on pages 41-46, including Tables 8 and 9, listing coating compositions having the at least about 6 weight percent of a corrosion-inhibiting carbon pigment.

**New Claim 128.**

Support for new Claim 128 is original claim 11.

**New Claims 129-130.**

Support for new claims 129-130 is found in original claim 18 and in the specification, for example, on page 26, which describes the claimed binders.

**New Claims 131-132.**

Support for new Claims 131-132 is found in the specification, for example, on page 21, which lists the claimed extender ranges.

**New Claim 133.**

Support for new claim 133 is found in the specification, for example, on page 20, par. [0066], which describes the claimed compounds.

**New Claims 134-137.**

Support for new claims 134-137 is found, for example, in original claim 19 and in the specification, for example, on page 24, par. [0075], which describes the claimed compounds.

**New Claim 138.**

Support for new claim 138 is original claim 87.

**New Claims 139-140.**

Support for new Claims 139-140 is found in the specification, for example, on pages 27-29, which describes the claimed method.

**New Claims 141-144.**

Support for new Claims 141-144 can be found in original claims 68, 77, 85 and 90, and in the specification, for example, on page 6.

**Claims 145-146.**

Support for new Claims 145-146 is found in the specification, for example, on page 30, par. [0095], which discusses an aluminum, aluminum alloy, magnesium or magnesium alloy substrate.

**Claims 147-150.**

Support for new Claims 147-150 is found in original claims 58, 77, 85 and 90, and in the specification, for example, on pages 13-14 and 31.

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### III. Response To The Restriction Requirement.

The Office has restricted Applicants invention into the following groups of claims:

- I. Claim 4.
- II. Claims {3}, {5}, 6, 96-104, and 122.
- III. Claims {1-2, 63-71}, {3}, {5}, 7-56, {81-86} 87-95, 105-119, 121, and 123.
- IV. Claims {1-2, 63-71}, {3}, and 72-80.
- V. Claims {1-2, 63-71}, {5}, 57-62, {81-86}, and 120.

Applicants traverse this Restriction Requirement on the basis that the Restriction is clearly erroneous and contrary to United States Patent Law and United States Patent Office practice and procedure.

#### 1. The Restriction Requirement Is Contrary To The Statutory Basis For Restriction.

Under 35 USC § 121, if two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. (See also, MPEP § 802). According to United States Patent Law, the other invention should then be filed in a separate divisional application, except as provided in 37 CFR 1.141.

The present Restriction Requirement is clearly erroneous in that the same invention is being restricted into multiple applications by the issuance of a restriction requirement in which claims overlap into multiple groups. Specifically, the Restriction Requirement is improper because it restricts a single claim into different Groups, which, according to proper restriction practice, cannot be patentable over each other. For example, Claims 1-2, and 63-71 are each listed in Restriction Groups III, IV, and V. As such, the *same* invention is being restricted into three different applications. If Applicants were to file separate applications for each of Restriction Groups II-V, this would result in the same invention being claimed in multiple applications. This is clearly contrary to the statutory basis behind restriction practice.

Further, for the inventions to be distinct, they must be patentable over each other. MPEP § 802.01. To meet the requirement that the inventions in each Group be distinct, it is necessary that each be "patentable (novel or nonobvious) over each other." Is it the position of the patent office that the claims of each Group are patentable over the claims of every other Group? If not, then the restriction requirement is improper. Given that the same invention (Claims) are being

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restricted into multiple different Groups, it does not seem possible that the claims of one Group could be patentable over the claims of the other Groups. Applicants request consideration of the above remarks and withdrawal of the Restriction on this basis.

## **2. The Inventions Are Related.**

Applicants' invention, as grouped in Restriction Groups (I), (II), (III), (IV), and (V), is Related. Each of the claims depends from claim 1. Thus, there is clearly a disclosed relationship between the claims and independence of the claims has not been asserted by the Examiner. Further, the Examiner has not shown that these Groups are distinct. Applicants request consideration of the following remarks and withdrawal of the Restriction on this basis.

### **a. The Office Has Not Shown That Groups (I) and (II), (III) and (II), (IV) and (II), and (V) and (II) are Distinct.**

In numbered paragraphs 3, and 7-9, the Office asserts that Inventions (I) and (II), (III) and (II), (IV) and (II), and (V) and (II) are related as product and process of use and that the inventions are distinct based on the assertion that the product as claimed can be used in a materially different process of using that product. In support of this, the Office asserts that the product as claimed can be impregnated into a fibrous substrate. Applicants do not agree with this assertion.

Initially, Applicants note that the Examiner's assertion of distinctness between the stated groups is wholly unclear. Each Restriction Group includes product (composition) claims as stated by the Office (i.e., each of Groups I-V is drawn to either "a corrosion-inhibiting coating composition" (Groups I, II, IV) or "an epoxy-based coating composition" (Groups III and V)). Thus, it is not clear which product the Examiner is referring to that could be used in a materially different process (i.e., impregnated into a fibrous substrate).

In addition, Applicants assert that the product as claimed would not be used in the materially different process stated by the Examiner. Applicants claim coating compositions, each having "one or more corrosion-inhibiting carbon pigments in an effective corrosion-inhibiting amount; and one or more binders." Each of the process claims also includes a coating composition having "one or more corrosion-inhibiting carbon pigments in an effective corrosion-inhibiting amount; and one or more binders." The Examiner states that the materially different process of using the claimed product is that "the product as claimed can be impregnated into a

fibrous substrate." This alternative use is not viable. Impregnating a "coating" into a fiber is not a reasonable alternate use. As is known to those of skill in the art, and as described in the specification, coating compositions are formulated to have suitable application properties such that the coating will adhere to a substrate. This formulation also prevents the coating from impregnating a fibrous substrate in any reasonable manner. By analogy, a commercial paint formulation (i.e., a coating) does not impregnate fibrous substrates that it comes in contact with, e.g., clothes, drop cloths, etc., but instead performs its specified function of coating these substrates.

Applicants request that the Examiner clarify which products are capable of the alternate use, and provide a viable alternative use of the claimed products or withdraw the Restriction as required in MPEP 806.05(h).

**b. The Office Has Not Shown That Groups (I) and (III), (I) and (IV), (I) and (V), (III) and (IV), (III) and (V), and (IV) and (V) are Distinct.**

In numbered paragraphs 4-6, and 10-12, the Office asserts that Inventions (I) and (III), (I) and (IV), (I) and (V), (III) and (IV), (III) and (V), and (IV) and (V), respectively are directed to related products. Under MPEP 806.05(j), restriction is only proper for related process invention if: (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; (B) the inventions as claimed are not obvious variants; and (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect.

In the present case, each of the inventions in Groups I-V overlap in scope (i.e., all the claims are limited to compositions having "one or more corrosion-inhibiting carbon pigments in an effective corrosion-inhibiting amount; and one or more binders.") In addition, the claimed products are clearly capable of use together. For example, the claimed compositions each have a carbon pigment and a binder and can additionally have one or more of amino acids, extenders, and/or rare earth compounds.

Accordingly, the Office has not met the burden as required under MPEP 806.05(j) of showing that the inventions are distinct and Restriction to the recited Groups is improper. Withdrawal of the Restriction requirement is hereby requested.

**3. A Combined Search And Examination Is Not Burdensome On The Examiner.**

Notwithstanding the Examiner's improper basis for restriction, it is Applicants' position that Restriction in this case to five Groups is wholly improper. In addition to showing that the inventions are independent and distinct, the Examiner must also show a serious burden by showing separate classification, status in the art, or a different field of search. MPEP § 803.

Each of Applicants' claims is limited to "one or more corrosion-inhibiting carbon pigments in an effective corrosion-inhibiting amount; and one or more binders." Accordingly, there is no additional burden for examining the claims together. Under MPEP 803, if the search and examination of all the claims in an application can be made without serious burden, the examiner MUST examine the claims on the merits, even though they include claims to independent or distinct inventions.

**4. Applicants' Invention Is Classifiable Together And Should Not Be Restricted.**

**a. Groups III and V should be Examined Together.**

In the event that the Examiner does not entirely withdraw the Restriction, Applicants request that Groups III and V be examined together, as is proper under USPTO guidelines. As stated by the Examiner, both Groups III and V are "drawn to an epoxy-based coating composition, classified in class 523, subclass 457 or 468." These are the *exact same* classifications and the claims in these groups should be examined together.

**b. Groups I and IV should be Examined Together.**

In the event that the Examiner does not entirely withdraw the Restriction, Applicants request that Groups I and IV be examined together, as is proper under USPTO guidelines. As stated by the Examiner, both Groups I and IV are "drawn to a corrosion-inhibiting coating composition, classified in class 106, with varying subclasses. These are the *exact same* classifications (with different subclassifications) and the claims in these groups should be examined together.

**IV. Provisional Election.**

Applicants do not concede the propriety of the Restriction. However, to fully reply to the outstanding Office Action, Applicants elect, with traverse, Restriction Group III, and without prejudice to pursue the non-elected claims at a future date in this or an appropriately filed continuing or divisional application. Also, with this election, Applicants request examination of independent Claim 1 and all Claims directly or indirectly dependent on Claim 1, including new

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**RESPONSE TO RESTRICTION REQUIREMENT**

Serial Number: 10/758,973

Filing Date: January 16, 2004

Title: CORROSION RESISTANT COATINGS CONTAINING CARBON

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Claims 124-133, independent Claim 63 and all Claims directly or indirectly dependent on Claim 63, including new Claims 134, 141 and 145, independent Claim 81 and all Claims directly or indirectly dependent on Claim 81, including new Claims 136 and 143, independent claim 87 and all claims directly or indirectly dependent on Claim 87, including new Claims 137, 138 and 144, and independent claim 92 and all claims directly or indirectly dependent on Claim 92. In addition, Applicants request rejoinder of the non-elected claims, where appropriate, should the elected invention be found allowable.

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 515-233-3865 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30 day of March, 2006.

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